

*Handwritten initials/signature in top right corner.*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/820,641 Confirmation No.: 8471  
Applicants : William H. Hohenstein and Andrew Von Zadora-Gerlof  
Filed : April 8, 2004  
TC/A.U. : 2859  
Examiner : Not Yet Assigned  
  
Docket No. : 4015.3002 US  
Customer No. : 000038473  
Title : WATCHCASE ADAPTED FOR A REMOVABLE  
ORNAMENTAL TOP

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. On	
<u>9/15/04</u> Date	<u><i>Rachel Meehan</i></u> Signature
<u>RACHEL MEEHAN</u> Typed or printed name of person signing certificate	

PETITION TO MAKE SPECIAL PURSUANT TO 37 CFR 1.102 (d)

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This petition is a Petition to Make Special under 37 CFR §1.102 (d) and MPEP §708.02 for accelerated examination. Included with this petition is the requisite fee pursuant to 37 CFR §1.17 (h) in the form of a check in the total amount of \$130. Please charge any deficiency or credit any overpayment in the fees that may be due in this matter to Deposit Account No. 502807. A copy of this letter is enclosed for accounting purposes.

09/20/2004 WRBDELRI 00000046 10820641 130.00 OP 01 FC:1460

REMARKS

Applicants submit that all claims in the above-identified application are directed to a single invention. In the alternative, if the Examiner believes that the claims recite more than one invention, Applicants will elect without traverse one of the inventions for further prosecution.

Applicants have conducted a preexamination search in Class 368, subclasses 231, 233, 235, 278, 283, 284, 285, using the Manual of Classification available at [www.upsto.gov](http://www.upsto.gov). Applicants have also reviewed the references cited on Form 1449 and Form 892 in a related U.S. application, USSN 10/031,375, including the references cited in the Office Actions in the related application. Applicants have also reviewed prior art and publications that Applicants are aware of. An Information Disclosure Statement with PTO Form-1449, listing all of the references found during the preexamination search is provided with this Petition. A discussion of the most relevant references and why they are distinguishable over the presently claimed invention follows.

Patents from Classification Search

U.S. Patent No's. 5,694,378, 2,757,508 and 4,430,004 were identified in Class 368 subclasses 233, 235, and 284, respectively. All three of these patents disclose clocks and not a watchcase as is presently claimed. Additionally, none of these patents discloses or suggests a watchcase having an upper case characterized by an upper surface having a track for removably receiving and securing an ornamental top as is claimed in claim 1 and all claims dependent thereon. These patents also do not disclose or suggest an ornamental top adapted to be worn on a watchcase comprising a) an upper surface adorned with an ornament; b) a flange on the bottom surface extending inwardly with respect to the watchcase from the upper surface of the watchcase; and c) having at least one bayonette extending further outwardly from the flange configured to removably engage in a track in the watchcase, as is claimed in present claim 21 and all claims dependent thereon.

References Cited in PTO Forms 892 and 1449 in related application USSN 10/031,375

U.S. Patent No's. 2,036,046 to Harrison and 2,513,465 to Fiske were cited by Examiner Miske in related application USSN 10/031,375 and used to reject the claims therein under 35 U.S.C. §103 in an Office Action dated June 10, 2004. Harrison is directed to a mantel clock characterized by a base having affixed thereon a member depicting stations defining a location on the world; a rotating time element which aligns to the stations, indicating the local time at that station. The clock is characterized by a hemisphere or map "securely fastened" (Page 1, second column, lines 51-54) to the top of the clock and stationary relative to the "member." Fisk, also directed to a mantel clock, also teaches a clock with rotatable bands. Fisk is characterized by a stationary and detachable top and rotating and removable middle sleeve. Fisk and Harrison do not teach a timepiece of size, weight or durability which is suitable for a watchcase, or suggest the desirability of doing so. Harrison and Fisk do not teach a timepiece that is characterized by an upper case capable of removably receiving an ornamental tip. Harrison and Fisk also do not disclose or suggest an ornamental top adapted to be worn on a watchcase wherein said ornamental top comprises: (a) an upper surface adorned with an ornament; (b) a flange on the bottom surface, extending inwardly with respect to said watchcase from the upper surface of the watchcase; and (c) at least one bayonette extending further outwardly from said flange configured to removably engage in a track in said watchcase, as does present claim 21 and all claims dependent thereon.

U.S. Patent No's. 2,444,392 to Willens, 4,858,209 to Chaut, 4,737,943 to Kienberger, and 4,985,877, were cited by Examiner Miske in related application USSN 10/031,375 and used to reject the claims therein under 35 U.S.C. §102 in an Office Action dated October 6, 2003. Additionally in that same Office Action, the Examiner cited Spadini, Swiss Patent Number 666 979, and Perrot, EP Patent 0 654 717.

Willens is directed to a clock characterized by a base and three different rotating time elements, one each for hours, minutes and seconds. Willens teaches that clocks according to his invention have the advantage of possessing "unusual visibility." Column 1, lines 43-48. The only size indication for these clocks is at Column 4, lines 52-53, where Willens compares the visibility of a six inches clock with a prior art clock of 18 inches. Clearly, such a clock is not suitable for a wristwatch.

Like Willens, Chaut is directed to mantel clocks having a plurality of rotating time elements. An essential feature of Chaut is that the clock is additionally transfiguring. Transfiguring clocks are characterized by a continuously changing geometrical shape. Chaut does not teach a wristwatch. Furthermore, the wristwatches of the present invention are not transfiguring in connection with their timekeeping. Spadini discloses a mantle or table clock with a rotating statuette within a glass dome. Perrot is directed to a means for attaching an element to the frame of a timepiece. Perrot does not describe, for example, a watchcase having an upper case with a track on its upper surface for removably receiving and securing an ornamental top. Kienberger is directed to a clock with a pendulum, which is not related to the currently claimed invention. Namisato is directed to a watch with a decorative magnetic member that is visible on the front face of the dial plate. The watchcase of the present invention does not have a front face dial plate.

In summary, none of the references described above disclose or suggest a watchcase comprising:

- (a) a lower case characterized by a first annular recess for receiving an optically transparent cylinder and a timepiece support for receiving a timepiece mechanism;
- (b) an upper case characterized by (i) on the bottom surface thereof, a second upper annular recess for receiving an optically transparent cylinder; (ii) on the upper surface thereof, a track for removably receiving and securing an ornamental top;
- (c) an optically transparent cylinder placed in said first and second annular recesses and between the lower and upper cases wherein the lower case, upper case and optically transparent cylinder are fixedly connected; as does present claim 1 and all claims dependent thereon. The above reference further do not disclose or suggest an ornamental top adapted to be worn on a watchcase wherein said ornamental top comprises (a) an upper surface adorned with an ornament; (b) a flange on the bottom surface, extending inwardly with respect to said watchcase from the upper surface of the watchcase; and (c) at least one bayonette extending further outwardly from said flange configured to removably engage in a track in said watchcase as does present claim 21 and all claims dependent thereon.

The remaining references cited on Form 1449 in related application USSN 10/031,375, namely U.S. Patent No's. 4,525,077 to Ketner, 4,817,064 to Milles, and 4,393,558 to Herwegh and German Patent 89 13 993 to Hsu were not cited by the

Examiner in an office action in the related application. However, these remaining references are discussed below.

Ketner discloses a watch having a large central opening extending through the main body of the watch and having a toroidal configuration that is capable of receiving an insert member, which may be decorative. The outer face of the watch comprises two concentric disks, one relating to hours, and the other relating to minutes. The concentric discs each rotate independently in relation to the main body or insert member which does not rotate and each of the discs are connect to a gear train which imparts proper time keeping. The watchcase of the present invention does not comprise an enlarged central aperture for receiving an insert member as is described in Ketner. Ketner therefore, does not disclose or suggest a watchcase having the combination of features of the presently claimed invention.

Milles discloses an assembly for mounting decorative elements on “holding elements.” Milles does not describe the watchcase of the present invention. Instead, Milles describes interchangeable elements for creating a wristband for supporting either a watch or other decorative element.

Herwegh discloses a fastener for detachable mounting of flexible sheets. Herwegh does not disclose or suggest the watchcase of the present invention.

Hsu discloses a combination pen holder and clock. Hsu does not disclose or suggest the watchcase of the present invention.

References cited in International Preliminary Examination Report of PCT application corresponding to related application USSN 10/031,375

In the International Preliminary Examination Report in the PCT application (PCT/US00/19728) corresponding to application USSN 10/031,375, new citations were made. U.S. Patent No's. 5,694,378 (“Totsuka”), 5,640,372 (“Thakara”), 4,939,913 (“Scungio”) and 5,412,625 (“Duchek”) were cited by the Examiner in the IPER in PCT Application No. (PCT/US00/19728). The IPER did not indicate that any of the claims reviewed therein lacked novelty or inventive step over Totsuka, Thakara, Scungio and Duchek.

Totsuka discloses a time display apparatus comprising partially transparent rotatable disks which are arranged concentrically with respect to one another wherein each disk comprises a graphical representation which jointly or separately produces special optical effects during rotary movement of the disks including display of the time. Totsuka does not disclose a watchcase comprising an upper surface for removably receiving an ornament and also does not disclose an ornament suitable for removably securing to the upper surface of a watchcase.

Thackara discloses a rotationally symmetric timepiece wherein the time information displayed along an axis and the time is indicated by elements that encircle the axis and move along the full length of the axis every 12 hours. Thakara does not disclose a watchcase comprising an upper surface for removably receiving an ornament and also does not disclose an ornament suitable for removably securing to the upper surface of a watchcase.

Scungio discloses a detachable ornament for a watch wherein the ornament can be positioned on top of the watch housing and has an opening therein through which the watch face is visible. The presently claimed watchcase does not have a watch face but instead has an upper surface comprising a track for receiving and removing an ornamental top. In Scungio, the ornament is not removably secured via a track on the upper surface of face of the watch as is presently claimed, or the dial of the watch described in Scungio would be obscured. Scungio instead provides an ornament having posts that extend below the plane of the ornament such that the posts click with recessed portions that allow the ornament to secure periphery of the watch housing.

Duchek discloses an ornamental graphic created by using reflective surfaces that is in the form of a clock. Duchek does not disclose a watchcase comprising a surface for removably receiving an ornament and also does not disclose an ornament suitable for removably securing to the upper surface of a watchcase.

#### Other Prior Art


Zapata, Janet, *The Art of Zadora: America's Faberge*, The Vendome Press, New York (1999), pages 136-141 ("Zapata"), shows decorative orbital or cylindrical clocks having detailed sculptures permanently affixed to their upper surfaces. Some of the upper

parts of the sculptures are removable to use as separate pieces of jewelry. As indicated in the description, the height of these clocks ranges from 5 to 16 inches. Given the size of these clocks and their ornamentation, Zapata does not disclose or suggest a small, light weight and highly durable watch case or other small wearable time piece. Furthermore, the clocks shown in Zapata do not have an upper case characterized an upper surface having a track for removably receiving and securing an ornamental top. The sculptures on the clocks disclosed in Zapata are permanently affixed to the upper surface of the clock. In contrast the watchcase of claim 1 is intended to have an ornamental top that is removable. Zapata also does not disclose or suggest the ornamental top of claim 21 that is removable form the upper surface of the watchcase.

In view of the above, Applicants submit that the requirements for the Petition to Make Special have been fulfilled. Applicants respectfully request that this Petition to Make Special be granted and that the present application be handled on an expedited basis.

Respectfully submitted,

ELMORE CRAIG, P.C.

By   
Darlene A. Vanstone  
Registration No.: 35,729  
Tel.: (978) 251-3509  
Fax: (978) 251-3973

Chelmsford, Massachusetts 01863

Date: 9/15/04